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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID CARROLL CHALLENGER

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Appeal 2008-1907  
Application 10/016,792<sup>1</sup>  
Technology Center 2400

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Decided:<sup>2</sup> May 6, 2009

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Before LANCE LEONARD BARRY, JEAN R. HOMERE, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed November 2, 2001. The real party in interest is International Business Machines Corporation.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-15, 17, 18, 20, 21, 23, and 24 mailed April 14, 2006, which are all the claims remaining in the application, as claims 16, 19, and 22 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## A. INVENTION

Appellant invented a system, method, and computer readable medium for transmitting a broadcast over the Internet by a broadcaster where users located approximately within a defined distribution area of the broadcaster can receive or interpret the broadcast. A broadcaster may transmit an encrypted broadcast over the Internet while transmitting a decryption key to users of computer systems over the air within its defined distribution area. Only users that are located approximately within the defined distribution area of the broadcast may receive the decryption key and hence be able to decrypt the encrypted broadcast. (Spec. 26, Abstract.)

## B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-15, 17, 18, 20, 21, 23, and 24. Claims 1, 6, 11, 17, 20, and 23 are independent claims. Claims 1 and 17 are illustrative:

1. A method for transmitting a broadcast over the Internet by a broadcaster where the broadcast is interpreted by users located within a defined distribution area of the broadcaster, comprising the steps of:

encoding a radio broadcast into a digital packets of information;  
encrypting said digital packets of information;  
transmitting said encrypted digital packets of information over the Internet; and  
providing a decryption key to a transmitter to be broadcasted within said defined distribution area of said broadcaster.

17. A method for transmitting a broadcast over the Internet within a defined distribution area, comprising the steps of:

receiving a request to transmit said broadcast from a requester;  
determining an physical location of said requester; and  
transmitting said broadcast over the Internet to said requester if said requester is physically located within said defined distribution area;  
wherein said step of determining said physical location of said requester comprises the steps of:  
capturing an Internet Protocol address of said requester;  
converting said captured Internet Protocol address of said requester into a computer name; and  
performing a trace of said request.

### C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Teare	US 5,243,652	Sep. 7, 1993
Schlossberg	US 2002/0066034 A1	May 30, 2002 (Filed Sep. 21, 2001)
Pezzillo	US 6,434,621 B1	Aug. 13, 2002 (Filed Mar. 31, 1999)

Franken                      US 2003/0097654 A1      May 22, 2003  
(Filed Jun. 15, 2001)

#### D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pezzillo in view of Teare; and
- (2) Claims 17, 18, 20, 21, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Franken in view of Schlossberg.

#### II. PROSECUTION HISTORY

Appellant appealed from the Final Rejection and filed a Twice Amended Appeal Brief (App. Br.) on June 11, 2007. The Examiner mailed an Examiner's Answer (Ans.) on August 14, 2007. Appellant filed a Reply Brief (Reply Br.) on October 4, 2007.

#### III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

##### *Pezzillo*

1. Pezzillo discloses "a system for enabling Internet or intranet broadcasting . . . Multiple webcast channels, or stations, can be created and managed, including Internet Radio . . . . The channels created can use a variety of media sources, including popular Internet streaming formats" (Abstract).

*Teare*

2. Teare discloses a system “to provide location-sensitive control over remote or mobile systems in a secure manner” (col. 1, ll. 34-36).

3. Teare discloses “a communication system comprising a remote mobile node including encrypted programming material, and a central facility. The central facility includes storage means for storing predetermined signature data each associated with a correspondingly respective code decryption key, wherein said signature data includes position and time information” (col. 1, ll. 40-47).

4. In Teare, “[t]he mobile node includes receiver means . . . and transmission means . . . The central facility further includes . . . means for comparing the location history to said predetermined signature data, and forwarding the corresponding key to said mobile node if the comparison satisfies a match condition” (col. 1, ll. 47-57).

5. In Teare, “[t]he authorization control signal is a code decryption key which is used at the remote node for decrypting the program” (col. 2, ll. 6-8).

6. Teare discloses that “the central facility may only authorize viewing of the encrypted video signal on an airplane if the plane is over 25,000 ft. altitude and over a predesignated area” (col. 2, ll. 40-42).

7. Teare discloses that “[t]he transmission may be accomplished by means well known to those skilled in the art, including transmission via a direct radio link” (col. 3, ll. 12-14).

#### IV. PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 US 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Brief to show error in the proffered prima facie case. Only those arguments actually made by Appellant has been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief has not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 US at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed

principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at 416. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 416. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 417.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element



for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 418. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

The Federal Circuit recently concluded that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (“[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children’s learning devices”). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the

result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 550 US 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 550 US at 1740-41).

## V. ANALYSIS

### *Grouping of Claims*

In the Brief:

**Group I:** Appellant argues claims 1, 3, 6, 8, 11, and 13 as a group (App. Br. 7-9). For claims 3, 6, 8, 11, and 13, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 3, 6, 8, 11, and 13 as standing or falling with claim 1.

**Group II:** Appellant argues claims 2, 7, and 12 as a group (App. Br. 9-11). For claims 7 and 12, Appellant repeats the same argument made for claim 2. We will, therefore, treat claims 7 and 12 as standing or falling with claim 2.

**Group III:** Appellant argues claims 5, 10, and 15 as a group (App. Br. 11-14). For claims 10 and 15, Appellant repeats the same argument made for claim 5. We will, therefore, treat claims 10 and 15 as standing or falling with claim 5.

**Group IV:** Appellant argues claims 4, 9, and 14 as a group (App. Br. 18-19). For claims 9 and 14, Appellant repeats the same argument made for claim 4. We will, therefore, treat claims 9 and 14 as standing or falling with claim 4.

**Group V:** Appellant argues claims 17, 18, 20, 21, 23, and 24 as a group (App. Br. 20-22). For claims 18, 20, 21, 23, and 24, Appellant repeats the same argument made for claim 17. We will, therefore, treat claims 18, 20, 21, 23, and 24 as standing or falling with claim 17.

*See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

### *The Obviousness Rejection*

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

### *Group I* *Claims 1, 3, 6, 8, 11, 13*

Appellant contends:

Teare instead teaches a mobile unit (e.g., aircraft) that stores encrypted signals. Teare further teaches that a central facility 12 which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25, 000 ft. altitude and over a pre-designated area. There is no language in the cited passage that teaches providing a decryption key to a transmitter to be broadcasted within a defined distribution area of a broadcaster.

(App. Br. 7).

Appellant further contends that “[n]either is there any language in the cited passage that teaches encrypting digital packets of information in which a radio broadcast was encoded into the digital packets of information” (App. Br. 9).

The Examiner found that “Teare discloses that the central facility may authorize the viewing of encrypted video signals when the plane is over 25,000 ft. and over a pre-designated area. This authorization is accomplished by transmitting (broadcasting) a decryption key to the plane. Since the plane is over the pre-designated area the key is broadcasted within the defined distribution area” (Ans. 6-7) (citations omitted).

**Issue:** Has Appellant shown that the Examiner erred in finding that the combination of Pezzillo and Teare discloses encoding a radio broadcast into digital packets, encrypting the digital packets, and providing a decryption key to a transmitter to be broadcasted within a defined distribution area?

The Examiner found that the combination of Pezzillo and Teare discloses encoding a radio broadcast into digital packets, encrypting the digital packets and providing a decryption key to be broadcasted within a defined distribution area (Ans. 6-7). We agree.

For example, Pezzillo discloses Internet broadcasting and creating Internet Radio, including streaming formats, based off of a radio broadcast (FF 1). Thus, we find that Pezzillo discloses encoding a radio broadcast into digital packets of information. Furthermore, Teare discloses a communication system that provides location-sensitive control over transmission of information (FF 2). For example, in Teare a remote node

includes encrypted programming material. A central facility storing a decryption key forwards the key to the remote node for decrypting the programming if a predetermined condition happens (FF 3-5). Teare forwards the decryption key to the remote node when the remote node is in a pre-designated area (FF 6). Thus, the claimed *encrypting said digital packets* reads on Teare's already encrypted information because encrypted information must inherently include a step of encrypting said information. In addition, the claimed *providing a decryption key . . . to be broadcasted within a defined distribution area* reads on Teare's transmission of a code decryption key to the airplane when the airplane is over a pre-designated area, so as to decode the programming. Teare's airplane would not receive the key if it was not in the pre-designated area. Such a location-sensitive embodiment suggests a defined distribution area for broadcasting the decryption key.

Given Pezzillo's teachings concerning Internet radio broadcasting and Teare's teachings involving broadcasting location-sensitive encrypted/decrypted information, we find that the Examiner has set forth a sufficient initial showing of obviousness and that the Appellant has not shown error in the Examiner's rejection. Appellant has not shown that the combination of Pezzillo and Teare lacks the above-noted disputed features of claim 1.

#### *Motivation to Combine Arguments*

Appellant contends that "[t]he Examiner's motivation does not provide reasons, . . . that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention,

would modify Pezzillo to include the above-cited missing claim limitations from claims 1, 6 and 11” (App. Br. 13). Appellant further contends that “[s]ince the Examiner has not provided a motivation for modifying Pezzillo to include the missing claim limitations of dependent claims 2-3, 5, 7-8, 20, 12-13 and 15, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15” (App. Br. 15).

The Examiner found that the “[m]otivation to do so would have been to provide location-sensitive control over remote or mobile systems in a secure manner, without requiring secure facilities for the remote or mobile node” (Ans. 4). The Examiner further found that “Pezzillo suggested securing the information by securing the connection. Therefore, one of ordinary skill in the art would be motivated to encrypt and therefore control (secure) the content of Pezzillo in the method taught by Teare” (Ans. 10).

**Issue:** Has Appellant shown that the Examiner failed to provide proper motivation for combining the teachings of Teare and Pezzillo?

Firstly, we note that for a *prima facie* case of obviousness to be established, the references need not recognize the problem solved by the Appellant. See *In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992); *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985) (“The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.”)

Secondly, there is no requirement that the problem solved by the secondary reference be discussed by the primary reference to apply the teachings of the secondary reference in a rejection under 35 U.S.C. § 103. The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider “the background knowledge possessed by a person having ordinary skill in the art” and “the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 US at 418 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions,” and the basis for an obviousness rejection must include an “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

Here, as noted *supra*, the Examiner has found actual teachings in the prior art and has articulated a rationale for the combination of known elements. As case law dictates, the references cited need not recognize the problem solved by the Appellant nor is there a requirement that the problem solved by the secondary reference be discussed by the primary reference to apply the teachings of the secondary reference. Further, the teachings suggest that the combination involves the *predictable use* of prior art elements according to their established functions. For example, Pezzillo teaches that it was known to create Internet Radio (FF 1). Internet broadcasts, such as Internet Radio, ordinarily include streaming digital packets. Teare teaches that it was known to have location-sensitive control over broadcasting decryption keys in order to decrypt information (FF 1-6). Thus, the combined teachings of Pezzillo and Teare demonstrate the

predictable use of decryption keys in location-sensitive control areas when broadcasting digital streaming of radio broadcasts. Accordingly, we find that the Examiner has provided sufficient motivation for modifying Pezzillo with the teachings of Teare, and we therefore will sustain the obviousness rejection of claims 1, 3, 6, 8, 11, and 13.

Again, we affirm the rejection of independent claim 1 and of claims 3, 6, 8, 11, and 13, which fall therewith.

*Group II*  
*Claims 2, 7, and 12*

Appellant contends that Teare does not teach “receiving said decryption key by one or more users of a computer system located within a defined distribution area of a broadcaster” (App. Br. 10).

The Examiner found that “[e]ach person on the plane is a user of the computer system because they are able to use the decrypted material and since the decryption key is combined in someway with the encrypted material to make it usable” (Ans. 8).

**Issue:** Has Appellant shown that the Examiner erred in finding that Teare discloses receiving said decryption key by one or more users of computer systems located within said defined distribution area?

We agree with the Examiner that Teare suggests that each person on the plane can be a user of the computer system within a pre-designated area. Further, we find that the airplane itself can be seen as a “user of a computer system,” for an airplane inherently includes sophisticated equipment such as



a computer system and the decryption key is transmitted directly to such equipment in the airplane when it is in a pre-designated area.

Thus, we find that the Examiner has set forth a sufficient initial showing of obviousness and that the Appellant has not shown error in the Examiner's rejection. Appellant has not shown that the combination of Pezzillo and Teare lacks the above-noted disputed features of claim 2. Therefore, we affirm the rejection of claim 2 and of claims 7 and 12, which falls therewith.

*Group III*  
*Claims 5, 10, 15*

Appellant contends that "Teare does not teach transmitting a decryption key via electromagnetic waves within a defined distribution area of a broadcaster" (App. Br. 12).

The Examiner found that "all radio waves are electromagnetic waves and Teare teaches the use of radio waves to communicate between the remote node and the central facility" (Ans. 8-9).

**Issue:** Has Appellant shown that the Examiner erred in finding that Teare discloses that the decryption key is transmitted via electromagnetic waves?

Teare discloses that the transmission may be accomplished by radio link (FF 7), and the Examiner found that this includes electromagnetic waves. We agree. Appellant has not shown how the claimed electromagnetic waves are distinguishable from Teare's direct radio link, which includes electromagnetic waves. Thus, we find that the Examiner has

set forth a sufficient initial showing of obviousness and that the Appellant has not shown error in the Examiner's rejection. Appellant has not shown that the combination of Pezzillo and Teare lacks the above-noted disputed features of claim 5. Therefore, we affirm the rejection of claim 5 and of claims 10 and 15, which falls therewith.

*Group IV*  
*Claims 4, 9, and 14*

Regarding claim 4, Appellant contends that “the Examiner’s motivation for modifying Pezzillo and Teare to include the above-noted claim limitation is ‘to allow the receiver to hear the digital broadcast.’ However, the Examiner has not provided any evidence that his motivation comes from any sources listed above. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness” (App. Br. 18).

The Examiner took Official Notice “that at the time of the invention it would have been obvious to a person of ordinary skill in the art to use an audio transducer to reproduce the digital broadcast. Motivation to do so would have been to allow the receiver to hear the digital broadcast” (Ans. 5).

**Issue:** Has Appellant shown that the Examiner’s motivation for taking Official Notice is improper?

We note that “motivation” need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick*

*Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006)(emphasis added); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom ...”).

Here, we find that the Examiner has properly relied upon common knowledge and common sense. The Examiner’s motivation does not have to refer to or come from any particular reference sought to be combine. In addition, as noted *supra*, the Examiner need not look for the same problem as the inventor. Furthermore, given that Appellant has not provided any evidence that discredits, criticizes, or otherwise discourages such a motivation, we find that the Examiner has set forth a sufficient initial showing of obviousness and that the Appellant has not shown error in the Examiner’s rejection. Therefore, we affirm the rejection of claim 4 and of claims 9 and 14, which falls therewith.

*Group V*  
*Claims 17, 18, 20, 21, 23, and 24*

Appellant contends that the “Examiner’s motivation for modifying Franken with Schlossberg to include the above-cited claim limitations is ‘to determine the physical location of a device on the Internet.’ The Examiner’s motivation is insufficient to support a *prima facie* case of obviousness”

(App. Br. 20). Appellant further contends that “[t]he Examiner’s motivation does not provide reasons . . . that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would modify Franken to include the above-cited missing claim limitation from claims 17, 20 and 23” (*Id.* at 21).

The Examiner found that “it would have been obvious to a person of ordinary skill in the art to use Schlossberg et al.’s method of tracing to determine the location in Franken et al. system. Motivation to do so would have been to determine the physical location of a device on the Internet” (Ans. 6).

**Issue:** Has Appellant shown that the Examiner’s motivation to combine the teachings of Schlossberg with Franken insufficient?

Again, Appellant attacks the Examiner’s motivation for combining references based on the “same problem” notion. As noted *supra*, the references need not recognize the problem solved by the Appellant, there is no requirement that the problem solved by the secondary reference be discussed by the primary reference to apply the teachings of the secondary reference in a rejection under 35 U.S.C. § 103, and a court need not find specific teachings, but rather may consider “the background knowledge possessed by a person having ordinary skill in the art” and “the inferences and creative steps that a person of ordinary skill in the art would employ. Thus, Appellant is relying on a flawed theory for providing motivation.

Here, the Examiner has found actual teachings in the prior art (Ans. 5-6) and has provided a rationale for the combination of known elements (Ans. 6). Further, the teachings suggest that the combination involves the

*predictable use* of prior art elements according to their established functions. For example, Franken and Schlossberg disclose prior art (e.g., transmitting a broadcast within a defined area and performing a trace of an Internet requester, respectively) that perform their ordinary functions to predictably result in a system that determines the physical location of a device on the Internet (Ans. 5-6). Accordingly, we find that the Examiner has provided sufficient motivation for modifying Franken with the teachings of Schlossberg, and we therefore will sustain the obviousness rejection of claims 17, 18, 20, 21, 23, and 24

## VI. CONCLUSIONS

We conclude that Appellant have not shown that the Examiner erred in rejecting claims 1-15, 17, 18, 20, 21, 23, and 24.

Thus, claims 1-15, 17, 18, 20, 21, 23, and 24 are not patentable.

## VII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-15, 17, 18, 20, 21, 23, and 24.

Appeal 2008-1907  
Application 10/016,792

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

pgc

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